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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/327,085 | 06/04/1999 | JOSEPH BACH | | 5016 |

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/327,085 | | BACH, JOSEPH | |
| | Examiner | | Art Unit | |
| | Naresh Vig | | 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in reference to response received 24 February 2003 to the office action mailed 16 January 2003. There are 4 claims, claims 1,2, 5 and 6 pending for examination.

Response to Arguments

Applicant's arguments and issues are responded to in the rewritten response to the pending claims using the same art as used in the Final Rejection mailed 28 June 2002.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 4 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and

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useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing an interactive audio system (ex. preamble of claim 1), the body of the claim discusses the specifics of method (the steps) executed by the interactive audio system. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claim is directed to interactive audio system claim, however, body of the claim discusses the specifics of method (the steps) executed by the interactive audio system.

Claim Rejections - 35 USC § 103

Claims 1, 2, 5 and 6 are rejected under 35 USC 103(a) as being unpatentable over August et al. US Patent 6,389,055 in view of Noreen et al. US Patent 5,303, 393.

Regarding claim 1, August teaches an interactive audio system (system and method for initiating a transaction using the wireless capture of information obtained from a video/audio device, and, more particularly from an audio device such as a radio in a car or home premises).

August does not explicitly teaches a home audio system having a user interface. However, August teaches display device [Fig. 6 and disclosure associated with Fig. 6]; Noreen teaches interface means to communicates the program signal to a user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify August as taught by August to communicate information to user [Noreen, col. 2, lines 45 – 53].

August in view of Noreen teaches:

a communication device for connecting said home audio system to a telephone [August, Fig. 5 and disclosure associated with Fig. 5];

an audio player for receiving music signal and audibly playing music pieces from said music signal [August, Fig. 1 and disclosure associated with Fig. 1];

a rider buffer for storing data corresponding to said music pieces; However, August teaches to allow user to purchase one of the items advertised, or order catalogs

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automatically, viewer simply presses the DIAL button, launching a telephone call, and then presses the SEND DATA button, sending captured data such as product information (obvious that rider/purchase data is stored), to an agent [August, Fig. 8 and disclosure associated with Fig. 8];

a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer [Fig. 6 & 8, and disclosure associated with Fig. 6 & 8];

an ordering interrupter [Noreen, col. 2, line 48];

wherein upon receiving a command from the user interface, said ordering interrupter instructs the communication device to establish communication with an ordering center via said telephone, and places an order [August, Fig. 8 and disclosure associated with Fig. 8] for a hard copy of the music piece corresponding to the data stored in said rider buffer (purchasing of product as taught by August and Noreen).

Regarding claim 2, August in view of Noreen teaches ordering memory having ordering data stored therein (sending captured data, such as product information, to an agent, who can verify the order using the additional information that was captured or stored in the device) [August, Fig. 8 and disclosure associated with Fig. 8].

Regarding claim 5, August in view of Noreen teaches communication device comprises a cellular phone [August, Fig. 4 and disclosure associated with Fig. 4].

Regarding claim 6, August in view of Noreen teaches communication device comprises a modem [August, Fig. 6 and disclosure associated with Fig. 6].

Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Naresh Vig', with a stylized flourish at the end.

Naresh Vig
Examiner
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December 11, 2005